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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Tojo et al.
Serial Number: 08/627,270
U.S. Filing Date: April 4, 1996
Group Art Unit: 3726
Examiner: P.W. Echols
Title: "Method and Machine for Forming
Protective Film on Sprayed Coating
of Large-Sized Product"



APPEAL BRIEF

Assistant Commissioner for Patents
Washington, D.C. 20231

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In connection with the subject application, and further to the Notice of Appeal dated

December 19, 2000, please enter this Brief on Appeal pursuant to 37 CFR 1.192.

REAL PARTY IN INTEREST

The real party in interest is the owner/assignee of the application, which is Honda
Giken Kogyo Kabushiki Kaisha.

RELATED APPEALS AND INTERFERENCES

This application is a divisional of USSN 08/398,881, which is also pending on appeal.

STATUS OF CLAIMS

Claims 1-42 have been in the application at various times throughout prosecution of
the application. Currently, claims 14-16, 19, 20, 26, 27, and 30-42 are pending in the
application, and of these claims 14-16, 19, and 34-36 stand withdrawn from consideration by
the Examiner as being drawn to a non-elected invention, while claims 20, 26, 27, 30-33 and

37-42 stand rejected under 35 USC §103(a) in the final Office Action of September 12, 2000, and the rejections of these claims is being appealed. Of these pending claims which are pending on appeal, Claim 20 is independent. A copy of claims 20, 26, 27, 30-33 and 37-42 on appeal is attached hereto as an Appendix.

STATUS OF AMENDMENTS

Subsequent to the Final Rejection, appellant has not filed any amendment. Prior to the Final rejection, appellant filed a Preliminary Amendment A dated April 4, 1996, an Amendment-B dated March 22, 1997, an Amendment-C, dated February 2, 1998, and an Amendment-D, dated November 17, 1999, all of which have been entered into the application file record.

SUMMARY OF THE INVENTION

The invention on appeal pertains to a vehicle manufacturing method involving formation of a protective film on a paint-finished automobile using a strippable paint, and particularly to such a method involving an automobile assembly process for thereby eliminating the need for certain steps of a conventional automobile assembly process.

Typically after an automobile is manufactured, but before it is shipped by the manufacturer (or a dealer) to a destination, it is initially kept in stock for an interval of time, which may in some cases be relatively long. During pre-shipment storage, dust, dirt and the like tends to accumulate on, and adhere to the paint-finished outer surface of the automobile, and these contaminants may damage the paint-finished surface. In order to prevent such damage, it is conventionally known to form a protective film on the paint-finished surfaces by applying a liquid, rust-preventing wax or a strippable paint.

In addition, during a manufacturing assembly line process, it is common to temporarily attach reusable scratch guards to vehicle fenders to avoid scratch damage by tools and

equipment as a vehicle under construction moves down the assembly line. However, these conventional scratch guards require labor to install and remove them relative to each vehicle, and necessitate a capital investment for acquisition and storage of the scratch guards when not in use.

In recent years, techniques for alleviating the burden of removing the protective wax film, at a destination of the automobile or for environmental purposes, have been disclosed. For example, in Japanese Laid-open Publication No. 267171/1991, a plastic film having a removable pressure-sensitive adhesive is pressed against the paint-finished surface of an automobile using a vacuum technique. Thus, the body surface is coated with such plastic film and is thereby temporarily protected from dust adhesion and the like. In the method of this Japanese publication, the entire surface of the automobile is covered with the plastic film, including portions which do not require protection, such as the windshield, which is not cost efficient.

With regard to smaller products, a strippable paint (usually water soluble) has been sprayed on the products to form a protective film thereon. Where a strippable paint is employed, it is possible to protect only desired portions, but if strippable paint is applied to a large product such as an automobile in a conventional manner, certain problems and disadvantages result. For example, if the spray coated object to which the strippable paint is applied is an automobile, the protective film lacks uniformity due to non-uniform drying, the film may be damaged by dust and other contaminants adhering to the surface of the coating, etc.

Further, contaminants such as dust, dirty water, rain water, etc. often adhere to the paint-finished surface of an automobile, and such contaminants hinders appropriate and smooth formation of a protective film when a strippable paint is applied thereto. Moreover,

the temperature of the paint-finished surface of the vehicle often drops, and this makes it difficult to form a protective film of the strippable paint on the surface. See page 1, line 13 - page 3, line 5 of the present specification.

Notwithstanding the disadvantages and problems associated with application of a strippable paint to a large object such as an automobile as discussed above, use of a strippable paint to temporarily protect paint-finished surfaces of an automobile has been generally proposed in US Patent 5,281,436 (Swidler), and this patent is the primary reference which the Examiner applies in the rejections of the Final Office Action.

The present invention has been developed to overcome the problems and disadvantages attendant the discussed conventional processes of forming strippable paint-type protective films on paint-finished surfaces of automobiles, and specifically to provide an efficient automobile assembly process incorporating same. See pages 1-4 and page 7, line 24 - page 8, line 22 of the specification.

With reference to Figs. 1 and 8 of the present drawings, a vehicle manufacturing method involving formation of a protective film on a paint-finished automobile using strippable paint includes the steps of:

painting the automobile so that it is paint-finished (43);
coating strippable paint on a painted surface of the paint-finished automobile (45); and
then assembling the paint-finished automobile by mounting an engine and functional parts thereto, while the strippable paint remains coated on the painted surface (44).

Such method according to the present invention, which corresponds to claim 20 on appeal, is very advantageous and desirable in the art because it efficiently combines the formation of a protective, strippable paint film on paint-finished automobile surfaces in a conventional automobile assembly line process such that some steps of the conventional

assembly process may be eliminated. Particularly, by coating the strippable paint onto the paint-finished surfaces *prior* to the step of assembling the engine and functional parts to the automobile, appellant has advantageously eliminated the conventionally necessary steps of applying and removing anti-scratch covers to prevent scratching of the paint-finished surfaces when assembling the engine and functional parts to the automobile. The claimed method eliminates the cost of the anti-scratch covers, as well as the cost of applying and removing same relative to the automobile, while otherwise protecting the paint-finished surfaces from damage by dirt, dust, etc. which is invariably generated during fitting-out or assembly step, as discussed at pages 25-26 of the present specification.

According to other important aspects of the of the invention as claimed, the assembly method involves other steps and features relating to drying of the coated strippable film to achieve a high quality protective coating, including: an elevated temperature drying step (9) after the strippable paint is coated on the automobile's paint-finished surfaces, including a step of preliminarily or partially drying (7) the strippable paint using a first drying means such as a source of infrared radiation, and subsequently, non-preliminarily or finally drying (8) the partially dried strippable paint using a second drying means such as a source of blown hot air; a stabilizing step (5) in which the strippable paint is stabilized at room temperature, in a setting booth for example, over a period of time prior to drying (9); a step of finished product inspection (46) subsequent to the assembling step; use of water based strippable paint; conditions of 15-30°C temperature and ambient humidity of 50-80% during the stabilizing step; and wherein the preliminary drying step promotes drying of the strippable paint coating from inside the coating, and the non-preliminary drying step promotes drying of the strippable paint coating from outside the coating. See page 14, line 6 - page 15, line 25 of the specification.

ISSUES ON APPEAL

I. Whether the vehicle assembly method of claim 20 is either anticipated under 35 USC §102(b) by US Patent No. 5,281,436 (Swidler), or in the alternative obvious under 35 USC §103(a) by the Swidler reference?

II. Whether the vehicle assembly method of claims 20, 26, 27, 30-33 and 37-42 is obvious under 35 USC §103(a) over Applicant's admitted prior art discussed at pages 20-21 of the specification in view of the Swidler reference and the state of the art?

III. Whether the vehicle assembly method of claims 20, 26, 27, 30-33 and 37-42 is obvious under 35 USC §103(a) over the Swidler reference in view of the state of the art?

GROUPING OF CLAIMS

The claims on appeal do not stand or fall together. Rather, each of the claims on appeal stands or falls on its own merits under one or more of the Issues above, as understood from the following arguments presented hereinbelow.

ARGUMENTS

The References

US Patent 5,281,436 to Swidler discloses an improved protective coating composition or strippable paint in the form of a mixture of water solubilized acrylic acid copolymer, ph-neutral acrylic copolymer, alkyl alcohol, surfactant and water, which composition may be used to form protective coatings on the surfaces of objects, and is environmentally friendly because it can be readily removed/dissolved using a ph-basic aqueous solution because such solution forms water-soluble carboxylate salts with the coating. Swidler also specifically discloses methods of using the composition, i.e., a method of protecting surfaces wherein a substantially continuous film of the coating composition is applied to the surface to be protected in a

thickness of 0.1 -10 mils, and is then permitted to dry under atmospheric conditions (although the composition may be diluted using 10% water or ethanol; a method of transporting (new) vehicles in which the vehicles' painted finishes are cleaned of debris and dust and then coated with the composition as described above so as to protect the finishes from scratches, the vehicles are transported to their destinations, and then the coatings are removed using aqueous solutions; and a method for protecting any sensitive finish from deleterious environmental factors by applying a coating of the composition to the finish prior to environmental exposure, and then removing the finish later when desired.

In the background portion of the Swidler patent, it is generally discussed that the paint finishes of new vehicles are subject to a variety of injuries both during the manufacturing process and during transportation from the assembly plant to retail locations, and that the finishes are especially prone to injury in the first months following manufacture because the finishes have not fully cured. It is also generally discussed that various solutions have been attempted to protect exposed surfaces of vehicles during manufacture and transportation, including physical protection (whereby the vehicle is covered with plastic or canvas) and chemical methods, but that such attempted solutions suffer from various drawbacks, i.e., use of canvas or plastic coverings is labor intensive and therefore prohibitively expensive for mass shipments or typical driving, and also create solid waste problems because they are not reusable, whereas chemical methods are difficult to apply and remove, suffer from high cost, and create health and environmental concerns because they are not water based.

At the paragraph bridging pages 20-21 of applicant's specification, it is discussed that anti-scratch covers are conventionally used during assembly of new automobiles to prevent scratching of paint finished surfaces, and specifically that the conventional assembly process involves steps of fitting and removing the anti-scratch covers to the paint finished surfaces,

and that the need for such covers and the fitting/removing steps is expensive in terms of the cost for the covers, cost of space and facilities for applying/removing the covers, and the added labor involved. The Examiner refers to this discussion as "applicant's admitted prior art on pages 20-21 of the specification."

The Rejections

As set forth at items 3-5 of the final Office Action, the Examiner has rejected: the vehicle assembly method of claim 20 as being either anticipated under 35 USC §102(b) by US Patent No. 5,281,436 (Swidler), or in the alternative as being obvious under 35 USC §103(a) in view of the Swidler reference; the vehicle assembly method of claims 20, 26, 27, 30-33 and 37-42 as being obvious under 35 USC §103(a) over Applicant's admitted prior art discussed at pages 20-21 of the specification in view of the Swidler reference and the state of the art; and the vehicle assembly method of claims 20, 26, 27, 30-33 and 37-42 as being obvious under 35 USC §103(a) over the Swidler reference in view of the state of the art.

Relative to the alternative anticipation/unpatentable rejection of claim 20, it is the Examiner's position that when considered "as a whole" Swidler's disclosure teaches toward the invention (rather than away) because he is mainly concerned with protecting new vehicle finishes, and discusses his method of transporting vehicles separately from generally protecting surfaces; and that it may be logically inferred from Swidler's disclosure (particularly the discussion under the Background of the Invention) that his coatings may be used during an assembly process, as well as during transportation.

Relative to the 103(a) rejections, it is the Examiner's position that one skilled in the art would have found it obvious to use Swidler's strippable paint in place of an anti-scratch cover (such as applicant has disclosed is conventionally used in automobile manufacturing)

during a vehicle assembly process, to realize the benefits thereof, that it is state of the art to perform a step of finished product inspection (claim 26) following an assembly step, and that the subject matter of the other rejected claims "is held to be matters of engineering design choice" because applicant's disclosure related to these limitations fails to teach that the limitations cause any new or unexpected results.

Appellant's Arguments

Issue I

Upon careful consideration appellant respectfully traverses the rejection of claim 20 as being anticipated by or obvious in view of the Swidler reference, and submits that claim 20 is clearly patentably distinct over the applied reference, because Swidler does not teach a vehicle manufacturing-assembly method, nor does he address any specific problems encountered during specific steps of an assembly process. Swidler's complete disclosure "as a whole" actually teaches away from the claimed method in that he generally mentions damage to vehicle finishes during assembly, manufacture and transportation, but the disclosed and patented aspects of his invention focus only on use of the coatings to prevent damage to vehicle finishes (and other sensitive object finishes) during storage and shipping relative to special considerations relating thereto. Swidler never teaches use of his coatings in relation to a vehicle manufacturing assembly process or any step thereof.

Although Swidler generally mentions (at his col. 1, lines 11-14 and lines 39-41) that vehicle finishes are subject to a variety of injuries during the assembly process and that various disadvantageous, physical and chemical solutions have been attempted to protect the exposed vehicle surfaces during manufacturing and transportation, Swidler's full disclosure of his actual invention has nothing to do with (and hence teaches away from) vehicle manufacturing-assembly.

Rather, Swidler is particularly concerned with "...damage in the first months following manufacture because the paint has not had sufficient time to cure", and especially during transit, while the specific prior physical solutions he discusses (at his col. 1, lines 41-46) relate to use of *non-reusable* plastic and vinyl covers which are "...prohibitively expensive for mass shipments or typical driving." Such non-reusable covers correspond to the plastic films of Japanese Laid-open Publication No. 267171/1991, and are plainly distinct from the *reusable* anti-scratch covers used during the conventional vehicle assembly process involving assembling of an engine and functional parts, as discussed at pages 20 - 21 of the present specification. Swidler's general disclosure and invention addresses nothing more than the conventional, disadvantageous practices occurring *subsequent* to final inspection of an assembled automobile, discussed at page 20, line 10 - page 21, line 17.

Relatedly, Swidler also fails to address or appreciate the advantages which are achieved by the present invention over conventional practices in the art, including the ability to more efficiently apply the strippable paint in terms of space and equipment during vehicle manufacture production via a production line, prevention of scratching, dust adhesion and the like to the paint finished surfaces during later stages of vehicle assembly, and elimination of conventional fitting and removal of anti-scratch covers before and after the assembly step, etc., as discussed at pages 20-26 of the specification. Instead, Swidler's invention is only discussed in terms of preventing damage to paint finished surfaces of the vehicle subsequent to vehicle manufacture-assembly.

In this regard, appellant respectfully submits that the Examiner's asserted position is not supported by Swidler's actual disclosure or the language of the claims on appeal. The present claims do not define use of the strippable paint in *general relation* to a vehicle manufacturing method, but rather in relation to a specific assembly step (i.e., mounting an

engine and functional parts to the vehicle "... while said strippable paint remains coated on the painted surface"). Swidler not only fails to generally disclose use of a strippable paint in a vehicle manufacturing method, but certainly does not disclose, anticipate or suggest this specific step in any way.

Issues II and III

Upon careful consideration appellant respectfully traverses such rejection, and again submits that each of claims 20, 26, 27, 30-33 and 37-42 is clearly patentably distinct over the conventional practices discussed at pages 20-21 of the specification, the Swidler reference, and the state of the art, for those reasons discussed above in relation to Swidler, because the proposed hypothetical modification of the prior art assembly process (involving conventional use anti-scratch covers) discussed at pages 20-21 of the application in view of a select teaching of Swidler is improperly based on a suggestion coming entirely from the Examiner (based on impermissible hindsight from applicant's disclosure), rather than from any teaching or suggestion which may be fairly gleaned from the actual prior art teachings considered as a whole, and because there is a complete lack of evidence necessary to establish a factual basis in support the Examiner's allegation that specific features of the dependent claims are "[obvious] matters of engineering design choice".

Impropriety of Proposed Modification

Regarding the proposed hypothetical modification, again, appellant respectfully submits that Swidler does not disclose a vehicle assembly process or the use of his protective coating compositions during any step of an assembly process, but instead exclusively focuses on the use of his coating compositions for protecting new vehicle and other object finishes during storage and transportation. As such, persons of ordinary skill in the art would not consider it obvious to somehow modify the conventional vehicle assembly process by replacing use of

conventional anti-scratch covers with use of protective films formed using Swidler's protective compositions, during the step of mounting of an engine and functional parts to the vehicle.

In this regard, applicant respectfully submits that the Examiner's interpretation of relevant portions of Swidler's disclosure is not supported by Swidler's actual, full, fair disclosure. For example, Swidler does not generally teach replacement of anti-scratch covers with his coating compositions, as the Examiner alleges. Rather, Swidler generally discusses that "Various solutions have been attempted to protect the exposed surfaces of vehicles during the manufacturing and transportation." However, in specifically discussing "Physical protection (e.g., covering the vehicle with plastic or canvas)", he also specifically discusses that such physical protection "... is prohibitively expensive for *mass shipments or typical driving* (emphasis added)" , thus very plainly limiting his proposed use of his coatings subsequent to the manufacturing of vehicles. Swidler also specifically discusses that the types of physical covers he proposes to replace "... create solid waste problems as they are not readily reusable", which is again contrary to the anti-scratch covers used during the prior art vehicle assembly method mentioned in the present specification (see page 23, lines 1-5).

In this regard, it is noted that the Courts and the Board of Patent Appeals and Interferences (BPAI) have consistently held that, for purposes of establishing obviousness under 35 USC §103, a rejection advanced by an Examiner must rest on a factual basis, with the facts being interpreted without hindsight reconstruction of the invention from the prior art, and that the Examiner may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis. Ex Parte Hamond, 41 USPQ2d 1217, 1220 (BPAI 1996), citing In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968).

The proposed hypothetical modification of specific steps of a conventional vehicle assembly process based on a select, general teaching of Swidler is just such impermissible speculation, unfounded assumption or hindsight reconstruction.

Failure to Establish Claim Limitations as State of the Art or
Matters of Engineering Design Choice

The Examiner's rejections of all of the dependent claims (26, 27, 30-33, and 37-42) are presented in summary fashion based on the Examiner's bald, unsupported allegations that performing a final inspection after an assembly step (claim 26) is state of the art, while all other limitations are "held to be matters of engineering choice... [because]... [t]he disclosure related to these limitations fails to teach any new or unexpected results." Appellant respectfully submits that such allegations are inaccurate, and do not otherwise constitute a factual basis necessary to establish prima facie obviousness under 35 USC §103(a).

In this regard, applicant respectfully traverses the Examiner's allegation that the inspection step of claim 26 is conventional in the manufacture of automobiles because, in fact, the claimed inspection step, *occurring after the strippable paint has been coated* on the vehicle's paint finished surfaces, is not conventional and is not shown to be conventional by any evidence of record.

On the other hand, appellant respectfully submits that there is no evidence of record showing that the features of the remaining dependent claims are matters of engineering design choice, i.e., a method of forming a protective film involving steps of preliminary drying and non-preliminary drying at elevated temperatures a strippable paint which has been coated on a paint-finished surface of an automobile using first and second drying means, as defined in claims 27, 30, 33, 37; the specific characteristics of the preliminary drying and non-preliminary drying steps as defined in claims 41-42; a step of stabilizing the strippable paint

after is it coated on paint-finished surfaces and before it is dried, as defined in claims 31-32; and the specific characteristics of the stabilization step as defined in claim 40.

Mere air-drying of a strippable paint at atmospheric temperature and pressure as disclosed by Swidler is plainly distinct from the stabilizing, preliminary drying and non-preliminary drying steps as defined in the rejected claims, and Swidler's air-drying does not achieve the high quality characteristics of a protective film as are achieved by the claimed features, as discussed at pages 14-15 of the present specification.

Also, appellant respectfully submits that there is a proper nexus between the advantageous features disclosed in the specification and the limitations of claims 27, 30-33 and 37-42, contrary to the Examiner's assertion. For example, claim 27 defines the preliminary and non-preliminary drying steps in terms of first drying means and second drying means, such that these features are in a means-plus-function format permitted under the last paragraph of 35 USC §112. Correspondingly, these features should be interpreted to include the structure, materials and acts defined in the specification, and equivalents thereof.

Further, although the advantages discussed in the specification are primarily applicable to water soluble strippable paints, which are used according to the preferred embodiments of the invention and the specific example disclosed therein, the specification does not indicate that the advantages are *exclusively* achieved with the water soluble strippable paints.

Moreover, it is not otherwise the purpose of the claims to fully or thoroughly define the invention, as the Examiner seems to suggest. Rather, such purpose is achieved by the specification, whereas the purpose of the claims is to patentably distinguish the invention over the prior art. It is appellant's position the present claims are patentably distinct from the prior art of record. Again, appellant respectfully submits that the above distinctions are very significant because they directly relate to primary aspects of the present invention which make

it advantageous over conventional processing systems, such as disclosed by the applied prior art.

Again, appellant notes the Ex Parte Hamond and In re Warner cases cited above. Further, the Courts have held that differences between a claimed invention and the prior art cannot be considered as matters of "mere design choice" where, as in the present matter, there is no teaching that would lead one of ordinary skill in the art to modify the prior art to include the specific limitations of the claimed inventions, and where the claimed invention achieves significant advantages over the prior art. See, In re Chu, 36 USPQ2d 1089 (Fed. Cir. 1995), and In re Gordon, 221 USPQ 1125 (Fed. Cir. 1984).

CONCLUSION

Based on all the foregoing comments, it is respectfully submitted that the Examiner has failed to establish prima facie anticipation under 35 USC §102(b) or obviousness under 35 USC §103(a) of any of claims 20, 26, 27, 30-33 and 37-42 on appeal. Correspondingly, appellant respectfully submits that the Examiner's rejections of the claims on appeal are in error, and a reversal of same is respectfully requested.

Appellant encloses herewith triplicate copies of the present Brief. The fee (\$310) for filing a Brief on Appeal has been previously paid in relation to the Brief on Appeal dated 25 November 1998, prior to the Examiner withdrawing the case from appeal to apply a new ground of rejection in an Office Action dated 07 June 1999. The Commissioner is hereby authorized to charge any deficiency which may be required during the entire pendency of the application, and to credit any excess paid during the entire pendency of the application, to Deposit Account 50-0744. A duplicate of this sheet is enclosed.

Favorable consideration and reversal of the final rejections are earnestly solicited.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to Commissioner of Patents and Trademarks, Washington, D.C. 20231 on February 20, 2001.

JPC/ms
Enclosures

Joseph P. Carrier

APPENDIX

1 20. A vehicle manufacturing method involving formation of a protective film on a
2 paint-finished automobile using strippable paint, the method comprising the steps of:

3 painting the automobile so that it is paint-finished;
4 coating strippable paint on a painted surface of the paint-finished automobile; and
5 then assembling the paint-finished automobile by mounting an engine and functional
6 parts thereto, while said strippable paint remains coated on the painted surface.

1 26. The method of claim 20, further including a step of finished product inspection
2 following the assembly step.

1 27. The method of claim 20, further including the steps of:
2 preliminarily drying said coated strippable paint using a first drying means; and
3 non-preliminarily drying the preliminarily dried, strippable paint using a second drying
4 means.

1 30. The method of claim 27, wherein said step of preliminarily drying said strippable
2 paint uses infrared radiation from said first drying means and said step of non-preliminarily
3 drying said strippable paint uses hot air from said second drying means.

1 31. The method of claim 27, further including the step of stabilizing the strippable
2 paint after it is coated on said product and prior to said preliminary drying step.

1 32. The method of claim 31, wherein said stabilizing step is performed at room
2 temperature.

1 33. The method of claim 27, wherein said preliminary and non-preliminary drying
2 steps are performed at elevated temperatures.

1 37. The method of claim 32, wherein said preliminary and non-preliminary drying
2 steps are performed at elevated temperatures.

1 38. The method of claim 20, wherein said strippable paint is water based.

1 39. The method of claim 27, wherein said strippable paint is water based.

1 40. The method of claim 31, wherein said stabilizing step is performed at a ambient
2 temperature of 15-30 °C and an ambient humidity of 50-80% .

1 41. The method of claim 27, wherein said preliminary drying step promotes drying of
2 said coated strippable paint from inside the coating, and said non-preliminary drying step dries
3 the preliminarily dried, coated strippable paint from outside the coating.

1 42. The method of claim 30, wherein said preliminary drying step dries said coated
2 strippable paint from inside the coating, and said non-preliminary drying step dries the
3 preliminarily dried, coated strippable paint from outside the coating.